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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,626	11/26/2003	Keith Yeats	ACO2758US1	7113

7590

02/15/2005

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/722,626

**Applicant(s)**

YEATS ET AL.

**Examiner**

Margaret G. Moore

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11 to 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 to 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The rejection under 35 USC 103 over Yamaki et al. has been withdrawn, as the Examiner has found a significantly closer reference. She apologizes for this delay in prosecution.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11 to 15 and 19 to 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milligan.

Milligan teaches a coating composition. Particular attention is drawn to column 12, lines 25 to 33. This teaches that "more concentrated" solutions having a solids content of at least 70 wt%, as high as 90 wt%, can be used. Thus Milligan anticipates the limitation in claim 11 of a solids content of more than 70 wt%. The solids content requirement had been the key point in applicants' previous arguments.

This composition contains a polymer having pendant curable groups, preferably silicon containing groups, and a polysiloxane. The bottom of column 4 through column 5 teaches an acrylic polymer. Column 5, lines 54 to 57, teaches including epoxy groups to improve adhesion. Preparation Examples 1 and 5 prepare acrylic polymers. Though they do not contain epoxy functional groups, the skilled artisan would have been motivated by the teachings of Milligan to include such groups in an effort to improve adhesion. Such a polymer would meet the requirements of the claimed glycidyl functional acrylic polymer, as well as claims 13 to 15.

The polysiloxane component is taught on column 7. See the formula on line 36 as it meets the polysiloxane formula in claim 11. Note line 56, which teaches a lower molecular weight value of 1500, generally 1800. This falls within the claimed molecular weight range. Column 8, lines 35 and on, teach a catalyst meeting the claimed harden-

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er. Column 12, lines 37 to 40, teaches curing at ambient temperature (instant claim 20). Column 1, lines 12 to 15, teach the substrates of claim 21.

Thus one having ordinary skill in the art would have been motivated by the teachings of Milligan to prepare an epoxy functional acrylic polymer (using epoxy groups to improve adhesion) and use it in combination with a polysiloxane meeting the formula in claim 11 and a hardener to form a coating composition. Milligan teaches a solids content of at least 70 wt%, thereby rendering obvious the instant claims.

With regard to claim 12, note that this is a product by process claim. As noted in the previous rejection, the process limitations per se do not appear to result in an inherently different product and as such they fail to distinguish the claimed glycidyl functional acrylic polymer from that found in the prior art.

4. Claims 16 to 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 16, Milligan fails to anticipate or render obvious a copolymer prepared from these particular reactants. While Milligan teaches the glycidyl methacrylate and butyl acrylate, there is no motivation to select these particular monomers in amounts as claimed. For claims 17 and 18, the prior art fails to teach or suggest these particular amounts of each component.

5. Upon reconsideration, the Examiner agrees that the obviousness type double patenting rejection over 09/888,696 should be withdrawn. There is nothing in the claims of '696 that suggests or renders obvious the inclusion of glycidyl groups in the acrylic polymer therein. The obviousness type double patenting rejection should have been over 6,743,854 (the parent application to the instant application; not that no restriction requirement was made in the parent).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


7. Claims 11 to 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 10 of U.S. Patent No 6,743,854. Although the conflicting claims are not identical, they are not patentably distinct from each other because, while the claims in '854 do not specifically recite a solids content, only the polysiloxane and the acrylic polymer are required by claim 1 in '854. In fact, the acrylic polymer is prepared in the presence of the polysiloxane. Such a composition will inherently have a 100 wt% solids content, falling within the range of greater than 70 wt%. Note that the polysiloxane and the glycidyl acrylic polymer in '854 are the same as claimed. Claims 2-10 in '854 correspond to claims 12 to 20. For claim 21, note that these substrates are embraced by the general term substrates in '854.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
2/10/05